

## **R E M A R K S**

Claims 1-4, 6, 8, 10, 11, 14-15 and 25-32 are pending in the above-referenced application. Claim 32 has been canceled.

Claims 8, 25-31 have been amended to more distinctly claim that which Applicant regards as the invention. Specifically claim 8 has been amended to recite that the claimed nucleic acid molecule **consists of at least 20 contiguous nucleotides within an intron region of SEQ ID NO:8** or its complementary sequence. Claims 25-29 have been amended to recite that SEQ ID NO:8 encodes a polypeptide having human adipocyte enhancer binding protein 1 activity. Further, claim 27 has been amended to recite in step (b) that the nucleotide sequence of SEQ ID NO:8 is compared with the nucleotide sequence of isolated genomic DNA of (a). Claim 29 has further been amended to correct editorial errors to recite in the preamble and step (b) “..nucleic acid sequence depicted in SEQ ID NO:8”. Claim 30 has been amended to correct a typographical error and recite that recited sequences are of SEQ ID NO:8. Claim 31 has been amended to depend from claim 8 and recite that the intron region is the sequence of nucleotides between positions 9015-10,641.

Applicant would like to thank Examiner J. Zara for her time and most helpful suggestions during her interview with Applicant’s representative, Cheryl H. Agris on February 9, 2009. The substance of the interview is provided below.

### **I. Substance of Interview**

#### **A. Brief Description of the Nature of an Exhibit Shown or Any Demonstration Conducted**

No exhibit was shown and no demonstration was conducted.

#### **B. Identification of the Claims Discussed**

Claims 8, 25-32 were discussed.

#### **C. Identification of Specific Prior Art Discussed**

Venter and Sulston were discussed.

#### **D. Identification of the principal proposed amendments of a substantive nature discussed**

The amendments of claims 8, 25-31 and the cancellation of claim 32 were discussed.

**E. The General Thrust of the Principal Arguments of the Applicant and Examiner**

Claims 8, 11, 14, 15, 30 and 31 are not anticipated by the cited prior art references. Claim 8 was amended to more clearly point out that it is directed to a fragment of an intron fragment of SEQ ID NO:8. There is no disclosure in Sulston or Venter of the isolated fragments recited in claim 8 and correspondingly in claims 11, 14, 15, 30 and 31.

The discussion also centered on rejoinder of claims 25-29 to the allowed claims. Applicant asserted that claims 25-29 are related to claim 1 as method of using a product recited in claim 1 (deemed to be allowable), e.g., SEQ ID NO:8 and thus subject to rejoinder in view of MPEP 821.04(b). Applicant asserted that the restriction of claims 8 and 30 should be withdrawn because in Applicant's view, the original restriction made was a species restriction. The Examiner stated that she would consider the arguments made. Further, the Examiner suggested that to more clearly recite the subject matter of the invention, claims 25-29 be amended to recite that SEQ ID NO:8 encodes a polypeptide having human adipocyte binding protein 1 activity. The Examiner further agreed to review searches performed on intron sequences.

**F. General Indication of Any other Pertinent Matters Discussed**

Applicant will also correct claim identifiers.

**G. General Results/Outcome of Interview**

Claims 8, 25-29, 30 and 31 have been amended. The Examiner will consider rejoining claims 25-29 and will consider arguments about the scope of claims, 8 and 30 and claims directed to any other intron fragments.

**II. Formal Matters**

It was asserted that the amendment to the claims filed on 6-25-08 does not comply with the requirements of 37 CFR 1.121(c) since *i.*) the marked up versions of the amendments do not accurately coincide with the previous set of claims, filed 1-27-08; *ii.*) the claims which are previously withdrawn from prosecution are incorrectly marked. In an attempt to provide compact prosecution, examination on the merits has been provided as set forth below. However, Applicant is required to provide an amended claim set in their response to the Office action,

complying with the requirements set forth below.

In response, Applicant notes that the marked up versions of the claims coincide with previous sets of claims. Furthermore, they all contain the correct claim identifier.

### **III. The Restriction Requirement**

It is asserted that the application contains claims 25-29, 32, drawn to an invention nonelected with traverse in the reply filed on 8-8-07 and that a complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

In response, Applicant asserts that claims 25-29 should be rejoined to the allowed claims, 1-4, 6 and 10 in view of MPEP 821.04(b). Applicant notes that MPEP 821.04(b) states

...if applicant elects a claim(s) directed to a product, which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder.

In the present case, claims 25, 27-29 contains all of the limitations of allowable claim 1; claim 26 depends from claim 1. Therefore, claims 25-29 meet the criteria of MPEP 821.04(b). Further, as discussed during the interview, claims 25-29 have been amended to recite that SEQ ID NO:8 encodes a polypeptide that has human adipocyte enhancer binding protein 1 activity.

Applicant asserts that it should not be necessary to limit claim 8 to just one intron sequence. In Applicant's view, the election of the intron region between positions 9015-10,641 constitutes merely a species election. Given that the linking claim, claim 1, is deemed to be allowable, the Restriction Requirement with respect to claim 8 should be withdrawn.

### **IV. The Rejections Under 35 USC §102**

Two references were cited. The basis is set forth below.

#### **A. Sulston**

Claims 8, 11, 14, 15, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sulston et al (Genome Res. Vol. 8, No. 11, pages 1097-1108, 1998). The Office Action specifically states:

Sulston et al teach recombinant host cells and compositions comprising a plurality of nucleic acid molecules including an isolated genomic nucleic acid construct comprising at least a 20 nucleotide fragment of the intron region of nucleotides 9015-10,641 of SEQ ID No. 8 and the complement thereof, which is optionally expressed in an appropriate host cell and which composition further comprises a carrier, and which polynucleotide is optionally labeled with a detectable substance (e.g., for sequencing the genome) (see entire document, see also alignment of sequences between SEQ ID NO. 8 and Pub Med No. 9847074 of Sulston et al provided in the Office action mailed 10-26-07).

Applicant respectfully traverses the rejection. Claim 8 has been amended to recite that it is a nucleic acid molecule **consisting of a** sequence at least 20 contiguous nucleotides within an intron region of SEQ ID NO:8 or its complementary sequence. Sulston does not disclose specific intron fragments. Thus, given that the nucleic acid molecule of claim is not anticipated by Sulston, it would follow that a fragment would not be anticipated either. Claims 11, 14-15, 30 and 31 depend from claim 8; thus arguments made with respect to claim 8 would apply to claims 11, 14-15, 30 and 31 as well.

In view of the amendment of claim 8 and the above arguments, Applicant asserts that the rejection of claims 8, 11, 14-15, 30 and 31 over Sulston et al. has been overcome. Therefore, Applicant respectfully requests that the rejection be withdrawn.

## **B. Venter**

Claims 8, 11, 14, 15, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Venter et al (USPN 6,812,339). The Office Action specifically states:

Venter et al teach recombinant host cells and compositions comprising a plurality of nucleic acid molecules including an isolated genomic nucleic acid construct comprising at least a 20 nucleotide fragment the intron of nucleotides 9015-10,641 of SEQ ID No. 8 and the complement thereof, which is optionally expressed in an appropriate host cell and which composition further comprises a carrier, and which polynucleotide is optionally labeled with a detectable substance (e.g., for sequencing the genome) (see SEQ ID No. 14,464 of Venter et al as set forth in the Office action mailed 10-26-07).

It is Applicant's view that Venter should not be prior art. The priority date of Venter is actually September 8, 2000. Applicant had previously submitted in the response to the Office

Action dated October 27, 2007, the provisional application (appln ser. no. 60/231,498 filed September 8, 2000) and Tables 1-25 accompanying said application. This application and tables were made of record in the Information Disclosure Statement previously submitted. SEQ ID NO: 14,464 is not disclosed in the appln. Ser. no. 60/231,498 or in Tables 1-25. The other applications filed, provisional applns. 60/241,755, 60/237,768, 60/231,498 were filed after the priority date of September 21, 2000.

Even assuming *arguendo* that Venter is prior art, the claimed invention would not be anticipated by Venter. Claim 8 has been amended to recite that it is a nucleic acid molecule **consisting of a** sequence at least 20 contiguous nucleotides within an intron region of SEQ ID NO:8 or its complementary sequence. Venter does not disclose specific isolated intron fragments of SEQ ID NO:8. Claims 11, 14-15, 30 and 31 depend from claim 8; thus arguments made with respect to claim 8 would apply to claims 11, 14-15, 30 and 31 as well.

In view of the amendment of claim 8 and the above arguments, Applicant asserts that the rejection of claims 8, 11, 14-15, 30 and 31 over Venter et al. has been overcome. Therefore, Applicant respectfully requests that the rejection be withdrawn.

In view of the above arguments, Applicant asserts that the rejection of the claims over Venter et al. has been overcome. Therefore, Applicant respectfully requests that the rejection be withdrawn.

#### **IV. Conclusion**

In view of the foregoing, Applicants assert that the claims are now in condition for allowance. Early action to that end is respectfully requested. The Examiner is invited to contact the undersigned at (914) 712-0093 if he has any questions.

Respectfully submitted,

Date: February 17, 2009

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